REMARKS

The Examiner is thanked for the careful examination of the application. However, reconsideration of this application is requested in view of the following remarks.

Claims 1-15 are pending in this application, with Claims 1-3 and 8-15 being independent.

Claims 1-4 and 6-15 are rejected as allegedly being obvious over U.S. Patent No. 6,801,935, hereinafter *Shen,* in view of U.S. Patent No. 6,175,831, hereinafter *Weinreich.*

Claims 1 and 2 define combinations of features including transmission of image data and a password to a designated printer, and transmission of the password to a designated addressee by E-mail. If the password transmitted by E-mail is entered into the printer and the password entered into the printer matches the password transmitted together with the image data, printing is performed on the basis of the image data. That is, the image data and the password are transmitted to a designated printer, and the password without the image data and E-mail are transmitted to a designated E-mail address. The password is then entered into the printer and the two passwords are compared. In fact, all of claims 1 – 4 and 6 – 15 relate to sending an e-mail with a password or certification information without image data.

Shen discloses secured printing using an electronic mailbox. As shown in Fig. 5 and described beginning in column 4, line 57 of *Shen*, a user first selects the "print to mailbox" option. Next, a user interface is displayed and the intended E-mail address in inputted. The print job is placed in an appropriate format and an E-mail

message is created that includes the print job, a user ID PIN and an optional security code. Finally, the E-mail message including the print job is sent to the inputted E-mail address. If a security code is included, the user is prompted to enter such (S809 in Fig. 8). Only upon entering the correct security code, will the user be permitted to print the print job. That is, the print job, ID PIN, and security code are sent to one location, i.e., to an e-mail address.

Shen does not teach sending an e-mail without image data to an addressee that includes a password that is specified in connection with the image data. The Examiner alleges that *Weinreich* overcomes the deficiency of *Shen*. The Examiner alleges that *Weinreich* teaches the e-mail transmission of a password separately from other information associated with that password, citing column 22, line 44 through column 23, line 19, particularly column 22, lines 44 – 49.

However, a careful review of *Weinreich* reveals that the *Weinreich* technology will not work with the *Shen* system. Specifically, the section of *Weinreich* relied upon by the Examiner relates to a situation where a member of a network organization loses his or her password. See column 22, lines 46 – 47. In such a case, a new password may be requested. If certain criteria are met, the new password is sent to the user's e-mail address. However, the new password is different than the original one and *the original password is invalidated*. See column 22, line 51.

Since the *Weinreich* technology relied upon by the Examiner relates to replacing and invalidating an original password, such technology would be incompatable with *Shen*. For example, if a new password was generated according to the *Weinreich* technology and sent separately to an e-mail address, the original password would be invalidated. Therefore, the original password that was sent to

the printer with the print job would no longer work because it would be different from the original password. *Weinreich* does not teach that the new password is compatable with a print job previously sent to another location, such as a printer. The new password is only useful for accessing the network.

Although, as alleged by the Examiner, *Weinreich* discloses a system wherein an e-mail is transmitted separately from other information associated with that password, *Weinreich* clearly does not teach that an e-mail containing a password authorizing a printing operation should be sent separately from the image data. The *Weinreich* system is completely different than the *Shen* system.

Furthermore, the *Weinreich* password is not primarily intended to authorize printing of a print job. The *Weinreich* password is primarily to enable a network member to access the network and retrieve information from the network.

Accordingly, the *Weinreich* technology is not compatable with the *Shen* technology. Furthermore, even if the *Weinreich* technology was applied to the *Shen* technology, it would not facilitate printing, since the new password would not work with a password previously sent to the printer.

The Examiner alleges that the suggestion or motivation for combining the references would be to enable a person who has forgotten his password to print image data protected by the *Shen* arrangement. However, as set forth above, the new password would not work with image data previously sent out under the *Shen* system.

Therefore, the rejection of Claims 1 and 2 is deficient at least because *Shen* and *Weinreich* are incompatable, and any reasonable combination thereof would not result in the present invention.

With regard to claims 3, 9, 11, and 12, the Examiner alleges that "the transmission of both data items to both devices is readable upon the claim language reciting that one is transmitted to one device and the other is transmitted to another device, in the absence of a specific statement that each data element is transmitted *only* to one or the other. That statement is not understood in view of the fact that each of the independent claims has been clearly amended to indicate that the password or certification information is transmitted without image data. The Examiner is respectfully requested to explain why the phrase without image data does not constitute the specific statement required by the Examiner.

Claims 1, 2, 3, 9, 10, 11, 12, and 13 were amended in the last response to define combinations of features including subject matter relating to transmitting image data to a device and also transmitting a set password without the image data by an E-mail to an address corresponding to a device other than the image data receiving device. The Examiner's rejection does not address the fact that Claims 1, 2, 3, 9, 10, 11, 12, and 13 define combinations of features including subject matter relating to transmitting a set password without the image data by an E-mail to an address corresponding to a device other than the image data receiving device. Accordingly, *Shen* is not as secure as the present invention. Since *Shen* does not teach the claimed subject matter, the rejection should be withdrawn.

Claims 4 and 6 – 8 depend from claim 3, and are thus patentable over the applied art at least for the reasons set forth above with respect to claim 3.

Claims 14 and 15 were amended in the last response to define combinations of features including subject matter relating to transmitting certification information without image data by an E-mail. The Examiner's rejection does not address the fact

that Claims 14 and 15 define combinations relating to transmitting certification information without the image data by an E-mail. Accordingly, *Shen* is not as secure as the present invention. Since *Shen* does not teach the claimed subject matter, the rejection should be withdrawn.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shen, Weinreich* and *Yacoub*. Claim 5 depends from Claim 1. As the rejection of Claim 5 does not remedy the deficiencies in the rejection of Claim 1, the rejection of Claim 5 should be withdrawn for at least the same reasons.

In view of the foregoing amendments and remarks, the Examiner is respectfully urged to find Claims 1-15 to be in condition for allowance.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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